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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,064

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Ulrich Sander

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HODGSON RUSS LLP  
ONE M & T PLAZA  
SUITE 2000  
BUFFALO, NY 14203-2391

EXAMINER

HARRINGTON, ALICIA M

ART UNIT

PAPER NUMBER

2873

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/761,064	SANDER, ULRICH	
	Examiner	Art Unit	
	Alicia M. Harrington	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 16-19 and 24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a):
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>0504,0104</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Information Disclosure Statement***

1. The Examiner has considered the information disclosure statement filed on 5/13/04 and 1/20/04.

***Claim Objections***

2. Claims 1-28 is objected to because of the following informalities: The claims should set forth the limitations without the need for element numbers enclosed in parenthesis. Appropriate correction is required.

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings fail to clearly differentiate the light beam beams and control signal paths. For example, page 4-section 18 of the specification details that an electronic image signal from the camera via image processing to the computer. The drawings fail to illustrate image data from control data, and the sequence of movement of either data signal.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the imaging system" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 12 will be examined as best understood by the Examiner.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1,2,4-7,9,10,12-15,20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Su et al (US 6,685,317).

Regarding claim 1, Su discloses a surgical microscope system for observing an eye of a patient, the surgical microscope system comprising:

A surgical microscope (35,36,7);

A beam splitter (32);

A retinal diagnostic device (via 15,16,17,50,19-24,18)-see col. 7 and col. 8.

Regarding claim 2, retinal lens (12 or 13)

Regarding claim 4, see figure 2.

Regarding claim 5, see col. 7, lines 14-35.

Regarding claim 6, output at element 3-figure 1.

Regarding claim 7, see figure 3 -#28.

Regarding claim 9, 21,22-see figure 2-col. 7, lines 20-42.

Regarding claim 10, 28,41-col. 8, lines 25-55.

Regarding claim 12, see figure 2; col. 7, lines 1-10.

Regarding claim 13, objective -7, retinal -13; col. 7, lines 10-25.

Regarding claim 14, see col. 7, lines 10-25.

Regarding claim 15, see col. 9, lines 1-5.

Regarding claim 20, see col. 7, lines 20-30.

Regarding claim 21, see col. 9, lines 1-9; the sensor processor (computer) command trigger signal.

Regarding claim 22, see col. 8, lines 35-52.

Regarding claim 23, a surgical microscope (35,36,7)-see figures 2a, 2; a beam splitter (32); a retinal diagnostic (via 15, 16, 17, 50,19-24, 18); microscope illumination (35,36); first light guide (28); an illumination source (42-see figure 3)-see col. 7-switching between retinal imaging and observation.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3,8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al.



Regarding claim 3, Su fails to specifically disclose the retinal lens contacts the patient's eye. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a retinal/object lens in contact with eye, since this is a known diagnostic method.

Regarding claim 8, Su discloses the illumination being a high-speed illumination source. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a stroboscopic light source because it would be an equivalent high-speed illuminations source and are readily available for imaging units.

Regarding claim 11, Su fails to specifically disclose a diffractive element and lens for in the imaging system. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a diffractive element for aid in correction of chromatic aberration since diffractive elements are typically used in optical system for this purpose.

***Allowable Subject Matter***

10. Claim 27-28 is allowed.

11. Claims 16-19,24-26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 27, prior art fails to specifically discloses a surgical microscope system for observing the eye of a patient, the surgical microscope system comprising a

surgical microscope, beam splitter, retinal diagnostic having a digital camera, camera beam path from the beam splitter, further comprising a beam transposer removably installed in the observation beam path between the stereo tube and beam splitter as claimed.

Regarding claim 16, prior art fails to specifically disclose a surgical microscope system for observing the eye of a patient, the surgical microscope system comprising a surgical microscope, beam splitter, retinal diagnostic having a digital camera, camera beam path from the beam splitter, retinal lens movable into and out of the observation beam path; a main objective and further comprising a beam transposer movable into and out of the observation path at a location between the main objective and patient's eye as claimed.

Regarding claim 24, prior art fails to specifically disclose a surgical microscope system for observing the eye of a patient, the surgical microscope system comprising a surgical microscope, beam splitter, retinal diagnostic having a digital camera, camera beam path from the beam splitter, a microscope illumination system, a first light guide, illumination source further comprising a second light guide arrange; and optical lighting branch switch connecting the first light guide and the second light guide to the illumination source , whereby light form the illumination source can be switched between the first light guide for use in transscleral retinal illumination and the second light guide for use in microscope illumination as claimed.

### ***Conclusion***

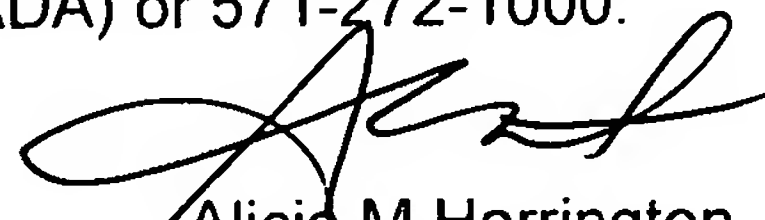


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Su et al (US 6,921,169) discloses a digital eye camera; Aizu et al (US 5,116,116) disclose an ophthalmologic diagnosis method.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Harrington whose telephone number is 571 272 2330. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571 272 2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Alicia M Harrington  
Primary Examiner  
Art Unit 2873

Amh